



### **Remarks**

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-60 are pending in the application, with claim 1 being the independent claim.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

### **Rejections under 35 U.S.C. § 102**

The rejection of claims 1 and 2 under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 3,100,775 to Kurt J. Rorig ("Rorig") is respectfully traversed.

The Office states that Rorig discloses a compound that reads on the instant claims (1-benzyl- $\alpha$ -phenyl-4-piperidinemethyl 3,4,5-trimethoxybenzoate hydrobromide (Rorig, Example 30, column 14, lines 55-65)). OA at page 7. Applicants respectfully disagree.

It is respectfully submitted that the compound in Rorig cited by the Office does not read on the instant claims. Specifically, the elected subject matter includes compounds where  $R^2$ - $R^6$  are defined in claim 1. OA at page 4. Claim 1 defines  $R^2$ - $R^6$  as follows:

$R^2$ ,  $R^3$ ,  $R^4$ ,  $R^5$ , and  $R^6$  are independently selected from hydrogen, halogen, alkyl, haloalkyl, hydroxyl, alkoxy, haloalkoxy, pentahalothio, alkylthio, cyano, nitro, alkylcarbonyl, alkoxy carbonyl, aryl, or aryloxy, ***provided that at least one of  $R^2$ ,  $R^3$ ,  $R^4$ ,  $R^5$ , and  $R^6$  are other than hydrogen;***

(emphasis added). By contrast, as the Office states, each of  $R^2$ ,  $R^3$ ,  $R^4$ ,  $R^5$ , and  $R^6$  in the compound in Rorig is H. OA at page 7. Accordingly, Rorig does not read on the instant claims.

Withdrawal of the rejection under 35 U.S.C. 102(b) is therefore respectfully requested.

***Rejections under 35 U.S.C. § 103***

The rejection of claims 1 and 2 under 35 U.S.C. 103 as allegedly being unpatentable over Rorig is respectfully traversed.

The Office has stated that:

One skilled in the art would have found the claimed compounds *prima facie* obvious for combining the instantly claimed specific compound and the general formula (I) as suggested by Rorig et al.

OA at page 11. Applicants respectfully disagree. As noted above, Rorig does not disclose a compound that reads on the claims of the present invention, nor does Rorig teach or suggest the claimed genus of compounds.

Moreover, the Office has not met its burden in showing that one of skill in the art would have been motivated to modify Rorig to arrive at the claimed genus of compounds. The Office must provide more evidence for motivation than a conclusory statement:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

MPEP § 2142 (citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

Indeed, no motivation exists to modify the compounds in Rorig to arrive at the instantly claimed compounds because, *inter alia*, the uses for the claimed compounds are entirely different than the uses taught in Rorig. Rorig teaches that "the subject compositions are selective CNS-depressant, anorectic, spasmolytic, and fungicidal agents; and especially the trialkoxybenzoates of this invention are characterized by an unexpectedly potent and diverse tranquilizing effect on the central nervous system." Rorig, column 2, lines 34-39. The compounds of the present invention, by contrast, have unexpected insecticidal activity.

Thus, the Office has not shown (a) that Rorig teaches or suggests the presently claimed compounds or (b) a motivation to modify the compounds described in Rorig to arrive at the presently claimed compounds.

Withdrawal of the rejection under 35 U.S.C. 103 is respectfully requested.

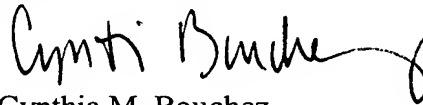
### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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Date: October 23, 2006

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